REMARKS

Claims 1-8 are all the claims pending in the application. Claims 1-8 stand rejected under 35 U.S.C. § 102(e).

Applicants respectfully thank the Examiner for accepting the drawings filed on February 3, 2000.

I.   Prior Art Rejection.

The Examiner rejected claims 1-8 under 35 U.S.C. § 102(e) as being anticipated by Tak-Shing P Yum, IEEE Transactions on Communications, Vol. 39, Ni, 8, August 1, 1991 (hereinafter "Yum"). Claims 1 and 5 are all independent claims. Applicants respectfully traverse this rejection for at least the reasons stated below.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach <u>every element and recitation of the Applicants' claims</u>. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

Claims 1-4

Applicants submit that Yum fails to disclose at least the following recitation of independent claim 1:

> request handling means, coupled between said
> request receiving means and a control input
> of said channel selecting means…

> request generating means, coupled to said
> request handling means..

The Examiner asserts that claim 1 is directed to a broadcasting unit and is anticipated by Yum.

The Examiner asserts that Yum's local switch is inherently equivalent to a broadcasting unit as

set forth in claim 1 (see pages 2-3 of the Office Action). Specifically, the Examiner asserts that

request handling means as set forth in claim 1 is inherently equivalent to the local switch sending

a copy of the requested program to customer or requesting a program if it is unavailable.

Applicants respectfully disagree with the Examiner. Applicants have carefully studied Yum's

discussion of the local switch, which does not have request handler means as set forth in claim 1.

Yum teaches a two level distribution network for broadcasting and interactive video.

Yum teaches replacing a large switch with smaller, local switches. This will increase reliability

and facilitate switch growth. In addition, local switches can be located at more convenient

locations and can process video requests independently, rendering a large call processor at the

central switch unnecessary (see Abstract and pg. 1268, col. 2, ¶ 2).

Specifically, Yum teaches a network system with local switches to handle customer

requests. The local switches receive a customer request and check whether the program is

currently being transmitted. If the program is available, a copy is transmitted to a customer.

Otherwise, the local switch sends a request for a copy of the requested program to the central

switch (see Fig. 1, pg. 1269, col. 1, ¶ 1).

However, Yum is concerned with the mathematical analysis and theoretical aspects of the

network system. Yum does not teach the actual implementation of this network system.

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Specifically, in Yum, the local switch is a black box, which sends copies of the requested programs to customers. For instance, Yum does not teach or suggest the way the means are organized or how customers' requests are handled. In particular, Yum does not teach or suggest a request handler means coupled between request receiving means and a control of input of the channel selecting means. Moreover, Yum does not teach or suggest a request generating means coupled to a request handling means. In short, Yum teaches a theoretical network <u>without</u> <u>teaching the actual implementation of the network</u>. Yum's local switch is a black box capable of performing some functions but how the local switch actually works is not disclosed in Yum.

Therefore, "request handling means" as set forth in claim 1 is not suggested or taught by Yum, which lacks request handling means which would be coupled between request receiving means and the input of said channel selecting means and coupled to request generating means. For these reasons, Applicants respectfully submit that independent claim 1 is patentably distinguishable from Yum. Applicants therefore respectfully request the Examiner to withdraw this rejection of independent claim 1. Also, Applicants respectfully submit that claims 2-4 are allowable at least by virtue of their dependency on claim 1.

Claims 5 to 8

Applicants submit that Yum fails to disclose at least the following recitation of independent claim 5:

> a second broadcasting unit ... with a limited
> selection of channels chosen from said
> plurality of television channels...

> wherein said second broadcasting unit
> process said first type of requests… and
> …sending a second type of requests…

The Examiner asserts that claim 5 is directed to a network with a second broadcasting unit and is anticipated by Yum. The Examiner asserts that Yum's local switch is equivalent to a second broadcasting unit as set forth in claim 5 (see pages 3-4 of the Office Action). Applicants respectfully disagree with the Examiner. Applicants have carefully studied Yum's discussion of the local switch, which does not have a limited selection of channels chosen from said plurality of television channels and different types of requests as set forth in claim 5.

As discussed above, Yum teaches a two level distribution network for broadcasting and interactive video (see page 6 of this Amendment). Specifically, Yum teaches a Central Switch (CS) with E number of input ports and M number of output ports. Yum further teaches $M>=E$, which means that E programs are simultaneously transmitted to the M output ports with some of them receiving the same program (see Fig. 1; pg. 1268, col. 2, ¶ 3). The M output ports supply the video programs to the local switches. In addition, as explained hereinabove, page 6, Yum's local switches are black boxes. The local switch receives a selection from a customer and if the program is not available, sends a signal to the CS (pg. 1269, col. 1, ¶ 1).

However, Yum teaches that local switches are supplied with programs and fails to teach or suggest local switches supplied with <u>a limited selection of E programs</u>. In addition, Yum does not teach or suggest requests from a customer being of <u>a different type</u> from the signal send from local switch to the CS. In short, Yum's local switch is a black box, which is capable of

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performing certain function but fails to teach how to perform these functions. In sum, Yum

teaches a theoretical network without teaching the actual implementation of the network.

Therefore, a second broadcasting unit with limited channels and different types of

requests as set forth in claim 5 is not suggested or taught by Yum, which lacks limiting the

number of channels supplied to local switches as well as having different types of requests.

For these reasons, Applicants respectfully submit that independent claim 5 is patentably

distinguishable from Yum. Applicants therefore respectfully request the Examiner to withdraw

this rejection of independent claim 5. In addition, Applicants respectfully submit that claims 6-8

are allowable at least by virtue of their dependency on claim 5.

II.   Improper Finality

A Non Final Office Action issued February 14, 2003, in the above-identified application,

in which claims 1-4 were rejected. Applicants filed an Amendment on March 2, 2003

(hereinafter "Amendment"), amending claims 1-4 for improved conformity with US practice and

improved clarity and adding claims 5-8, which did not necessitate additional searches for the

Examiner. In fact, on page 5 of the Amendment, Applicants explained that "the claim

amendments are made solely for the purpose of improved readability and conformance with U.S.

practice".

The Examiner asserts that replacing such words as "adapted to select" with "selecting"

necessitated new grounds for rejection (see page 5 of the Office Action). However, an artisan of

ordinary skill in the art will recognize that the two phrases have substantially similar meanings.

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In short, Applicants' response did not **(and could not)** necessitate the new grounds for rejection

of claims 1-8. See MPEP § 706.07(a) which states:

> that a second or any subsequent action on the merits shall be final,
> **except** where the Examiner introduces a new ground for rejection
> that is: (1) not necessitated by an applicant's amendment of the
> claims or (2) based on information submitted in an information
> disclosure statement filed during the period set forth in 37 C.F.R. §
> 1.97(c)).

In this Office Action dated July 31, 2003 (hereinafter "Office Action"), the Examiner

indicated that claims 1-8 are rejected. However, the Examiner indicated that Applicants'

arguments with respect to claims 1-8 have been considered but are moot "in view of the new

grounds for rejection" (see page 5 of the Office Action). Specifically, in this Office Action, the

Examiner rejected claims 1-8 using Tak-Shing P Yum for claims 1-8, only, as opposed to the

previous Office Action dated February 14, 2003, where the Examiner rejected claims 1-8 using

Rao. In short, in this Office Action, the Examiner provided a new references, which was not

previously made of record.

Therefore maintaining a final rejection where new rejections are made in the absence of

substantive amendments to the claims by the Applicants, is improper. *The improper finality of*

the Office Action robs Applicants of the opportunity to respond by amending the claims as of

right in the face of prior art references that should have been made of record by the Examiner in

the first Office Action. In view thereof, Applicants respectfully request the Examiner to

withdraw the finality of the Office Action and reopen prosecution for the reason that Applicants'

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/517,691
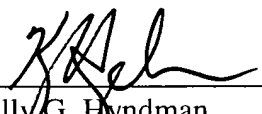ATTORNEY DOCKET NO. Q58016

Response under 37 C.F.R. § 1.111 filed November 27, 2002, did *not* necessitate the new grounds

of rejection.

III.   Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

                                        Respectfully submitted,

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Date: October 31, 2003

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